

REMARKS

This application has been carefully reviewed in view of the above Office Action. Reconsideration is requested in view of the following:

Objection to the Drawings

Responsive to the objection to the drawings, a new Figure 15 is submitted herewith with reference number 520 in the "ENTERPRISE NETWORK" corrected to 500. Reference label 502 has been corrected in the specification. In view of these corrections, approval of the drawings as amended is respectfully requested.

Objection to the Specification

The matters objected to in the specification have been corrected. Applicants appreciate the Examiner bringing these matters to their attention. Reconsideration of the specification and withdrawal of the objection is respectfully requested.

Objection to the Claims

The minor error in claim 31 has been corrected. Applicants again thank the Examiner for bringing this minor error to their attention for correction. Reconsideration and removal of the objection to claim 31 is respectfully requested.

The Double Patenting Rejections

Regarding the double patenting rejections to claims 1, 17 and 36 based upon U.S. patent no. 6,670,537, the undersigned submits herewith a terminal disclaimer obviating all such rejections. It is noted that the inventorship, ownership and filing date of the present application is identical to that of patent number 6,670,537. Reconsideration and allowance is respectfully requested.

Regarding the double patenting rejection of claims 2-8, 10-15, 18-23, 25-30, 32-35, 27-41, 43-46 and 48-51, it is submitted that the terminal disclaimer accompanying S/N 09/838,983

this response also obviates these rejections. While it is asserted that these claims are anticipated by claims 2-6 and 8 of U.S. patent 6,670,537, it is respectfully noted that this is inconsistent with an obviousness-type double patenting rejection of claims 1, 17 and 36. It is fundamental that in order for there to be anticipation, each and every claim element must be present in the cited reference. It is also fundamental that a dependent claim incorporates by reference each and every limitation of the claim or claims from which it is dependent. Given, for example, that claim 1 is indicated as being rejected based upon obviousness-type double patenting, it would appear that the addition of features in a dependent claim (e.g., claim 2) could not possibly be anticipated. It is accordingly believed that the Examiner's intent was that all claims were to be rejected based upon obviousness-type double patenting. Thus, the enclosed terminal disclaimer is believed to be adequate to overcome this rejection.

The Obviousness Rejections

Regarding the rejection to claim 1 based upon the Microsoft Mail art and the Hurtado patent, claim 1 has been amended to clarify that the attachment of the predefined audio sample is a "default" audio sample (as described on page 12 of the specification). The original terminology was intended to embrace this, but upon review the undersigned feels that use of the term "default" may be more descriptive, without affecting the scope of the claim. The undersigned finds no suggestion or teaching of a single button actuation carrying out attachment of a default music sample clip as claimed in claim 1. In fact, it is noted that the process outlined on page 13 of Microsoft Mail clearly involves more than the single command called for in claim 1 and involves no suggestion of a default attachment of any sort. Page 13 of the Microsoft Mail reference appears to indicate that three steps are required (steps 3-5) as follows:

"

- 3- click the ATTACH button.
- 4- Select the file(s) that are to be attached and then click ATTACH.
- 5- Click the CLOSE button to complete the attachment

"

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Thus, although Microsoft Mail shows an attach icon, it functions in a different way than that prescribed by claim 1. The undersigned finds no disclosure in Hurtado adequate to supplement Microsoft Mail in any way which contributes to the rejection. Neither reference reasonably teaches or suggests a single click actuation of attachment of a default music clip attachment. By contrast, in certain embodiments consistent with claim 1, once a default music clip attachment is defined, a user can attach the music clip to any or all outgoing emails by clicking the attach button 434 as described on page 12 of the specification, for example. Accordingly, claim 1 is believed allowable as originally submitted. Reconsideration of claim 1 as amended for clarity is respectfully requested.

Regarding the rejection to claims 2-8, it is noted that each of these rejections appear to be based in part upon the Microsoft Mail reference. In view of the above deficiency in the Microsoft Mail Art, there can be no *prima facie* obviousness of the dependent claims. Reconsideration of claims 2 through 8 is respectfully requested.

Regarding the rejection to claim 9, this claim has also been amended to clarify the intended meaning without effect to the claim scope. Upon review of the explanation of the rejection in the Office Action, the undersigned was unclear as to the Examiner's point regarding forwarding of emails. However, it is believed that she intends to read claim 9 upon the action of forwarding of an email. It is not believed that this is a viable reading of claim 9 as originally presented, but this claim has been amended to clarify that a music sample is attached to each email generated. This is believed to clearly distinguish over the forwarding situation raised by the Examiner.

The Office Action asserts that it would be obvious to use the forwarding feature to facilitate ease in spreading music samples that would lead to sources of revenue. While this is certainly a perceived advantage of certain embodiments consistent with

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claim 9, the motivation to distribute music samples to generate revenue alone is inadequate to lead to the invention as characterized by claim 9. There must be some suggestion in the art to combine the actual claim elements in the manner prescribed by the claim (including those elements missing from the cited art) in order to establish *prima facie* obviousness. This burden has not been met. Moreover, the art taken individually or collectively does not disclose or suggest a system in which music samples are automatically attached to all emails generated by the sender as claimed. Accordingly, reconsideration and allowance of claim 9 is respectfully requested.

Regarding the rejections to claims 10-16, the remarks associated with claim 9 are equally applicable. Reconsideration and allowance of claims 10-16 are respectfully requested.

Regarding claim 17, this claim has also been amended to clarify that the "audio sample" comprises a "default audio sample", as with claims 1 and 9 above. Accordingly, the above comments are believed equally applicable. Reconsideration and allowance of claim 17 are respectfully requested.

Regarding claims 18-23, these claims are dependent from claim 17, and thus the above remarks are also equally applicable. Reconsideration and allowance of claims 18-23 are respectfully requested.

Regarding claim 24, this claim has also been amended to clarify that the "audio sample" comprises a "default audio sample", as with claims 1, 9 and 17 above. Accordingly, the above comments are believed equally applicable. Additionally, the Office Action asserts that it would have been obvious to adapt Microsoft Mails "to allow an audio file as a signature so a user could easily redistribute the file and this would lead to sources of revenue through redistribution of content". The Office Action points to column 2, line 3 of the Hurtado reference in support of the obviousness to make this

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combination/modification. The full statement by Hurtado at column 2, line 3 is as follows:

"The deployment of an electronic distribution system provides the digital content providers the ability to achieve fast settlement of payment through immediate sales reporting and electronic reconciliation as well as gain secondary sources of revenue through redistribution of content."

Respectfully, the undersigned fails to see how this statement taken in context in any way suggests modification of Microsoft Mail in order to use a default music sample as a signature in order to distribute the default music sample with each email as suggested by the Office Action. It is respectfully submitted that a hindsight reconstruction of Applicants' invention is the only viable explanation for the current rejection. Reconsideration and allowance of claim 24 are respectfully requested.

Regarding claims 25-30, these claims are dependent from claim 24, and thus the above remarks are also equally applicable. Reconsideration and allowance of claims 25-30 are respectfully requested.

Regarding claim 31, this claim has been amended to correct the grammatical error noted by the Examiner, but otherwise stands unamended. The undersigned reiterates the above deficiencies of the Microsoft Mail art which only discloses that an attachment can be made to an email using the three steps described above. The undersigned is unable to find any teaching or suggestion of an enterprise email server which attaches music samples to emails passing therethrough in the manner claimed. The Office Action points to the Fritsch reference at column 1, lines 25-26 for the only suggested motivation, i.e. to "facilitate users easily and quickly purchasing music". The undersigned questions the premise that the motivation to easily and quickly purchase music can provide adequate basis for making any claim combination. If so, it would

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appear adequate to provide justification for combination of any and all possible claim elements that achieve this rather broad result! Clearly this cannot be an appropriate motivation to make the proposed combination. Moreover, the language of the full quote from Fritsch should be examined. It states:

“A need therefore exists for a system and method that provide a music web site that is comprehensive, versatile, user-friendly, and protects the proprietary rights of artists and other rights holders.”

The undersigned is at a loss to understand how an allegation of the existence of a need for a music web site as stated above can possibly suggest to one of ordinary skill in the art that an enterprise server can be used to attach music samples to emails. Reconsideration and allowance of claim 31 are respectfully requested.

Regarding claims 32-35, these claims are dependent from claim 24, and thus the above remarks are also equally applicable. Reconsideration and allowance of claims 32-35 are respectfully requested.

Regarding claim 36, this claim has also been amended to clarify that the “audio sample” comprises a “default audio sample”, as with claims 1, 9 and 17 above. Accordingly, the above comments are believed equally applicable. Reconsideration and allowance of claim 36 are respectfully requested.

Regarding claims 37-41, these claims are dependent from claim 36, and thus the above remarks are also equally applicable. Reconsideration and allowance of claims 37-41 are respectfully requested.

Regarding claim 42, this claim has also been amended to clarify that the “audio sample” comprises a “default audio sample”, as with claims 1, 9, 17 and 36 above.

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Accordingly, the above comments are believed equally applicable. Reconsideration and allowance of claim 42 are respectfully requested.

Regarding claims 43-46, these claims are dependent from claim 42, and thus the above remarks are also equally applicable. Reconsideration and allowance of claims 43-46 are respectfully requested.

Regarding claim 47, the above remarks regarding claim 31 are equally applicable. Reconsideration and allowance are respectfully requested.

Regarding claims 48-51, these claims are dependent from claim 47, and thus the above remarks are also equally applicable. Reconsideration and allowance of claims 48-51 are respectfully requested.

The undersigned additionally notes that numerous other distinctions exist between the cited references and the invention as claimed. However, in view of the clear deficiencies in the art as pointed out above, further discussion of these distinctions is believed to be unnecessary at this time; failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position.


No amendment made herein was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim unless an argument has been made herein that such amendment has been made to distinguish over a particular reference or combination of references.

In view of this communication, all claims are now believed to be in condition for allowance and such is respectfully requested at an early date. Should the Examiner feel that further issues remain to be addressed, the undersigned respectfully requests

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the courtesy of a telephone interview to assure that the current rejections and arguments are clear issue prior to issuance of a further Office Action. The undersigned can be reached at the telephone number below.

Respectfully submitted,



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Dated: 11/23/2004

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